

REMARKS

Introduction

In accordance with the foregoing, claims 1, 2, 5, 7, 13 and 14 have been amended and claims 17 and 18 have been added. No new matter is being presented. Therefore claims 1-10 and 12-18 are pending in the application and reconsideration is respectfully requested.

Rejections under 35 U.S.C. § 112

The Office Action rejected Claims 5-10 and 12-16 under 35 U.S.C. § 112, second paragraph.

First, applicant thanks the Examiner for the thorough review. Applicant has made all the requested corrections, as follows :

Concerning claims 5 and 13-14, the expression "said box" has been corrected to "said paper dispenser".

Concerning claim 7, the dependency thereof has been changed to claim 2.

Concerning claims 13 and 14, the expression "inner wall" was corrected to "interior wall".

Concerning claims 5-10 and 12-16, the preamble has been amended as follows : "A paper dispenser made of a folded single sheet of pliable material and having a substantially frustopyramidal exterior shape"; and the reference to the cross-shaped center portion has been amended as follows : "said single sheet of pliable material, prior to folding, having a substantially cross-shaped center portion and four side portions". Henceforth, it is now clear that the claims on file do not refer to two different inventions, but refer to the same article to better define the article by referring to both its folded state, and its unfolded state.

Applicant therefore respectfully requests reconsideration and withdrawal of the outstanding rejections under 35 U.S.C. 112.

Rejections under 35 USC § 103

The Office Action rejected all claims on file under 35 USC § 103, citing AUERBACH (US Patent 1,492,951) as primary reference.

Firstly, Applicant disagrees with the following aspects in the determination of the scope of AUERBACH presented at paragraph 9 of the Office Action : 1 that AUERBACH discloses a paper dispenser; and 2. that AUERBACH discloses a paper-receiving compartment. Moreover, the Office Action does not appear to point to any reference which teaches paper dispensing.

In fact, AUERBACH discloses “containers for merchandise and particularly for candy or similar articles” (lines 9 to 11). This points diametrically away from paper dispensing and addresses far different needs. For instance, exposing articles with means “for separating various assortments” is an object of containers for candy or similar articles, whereas this is completely nonsense in the context of paper dispensing. In fact, the use of separators (see Fig. 1, numerals 40, 41) would actually prevent rectangular papers from fitting inside the container. It is well established that prior art must be considered in its entirety, including disclosures that teach away from the claims. (MPEP 2141.02 VI; *W. L. Gore & Associates, Inc. v. Garlock, Inc.*). The Office Action appears to ignore this aspect by assuming that adapting AUERBACH’s container for dispensing paper would have been obvious. Given the weight of the contradiction due to the presence of the separators, Applicant can only disagree with this finding.

Continuing nonetheless, the Office Action acknowledges, at paragraph 9, that “AUERBACH fails to disclose at least one of the interior walls has an exterior face having an illustration or marking and in at least one of said exterior walls comprises an opening allowing to see therethrough the illustration or marking on the interior wall, but appears to argue that it would have been obvious for a person of ordinary skill in the art to *combine* the teachings of

AUERBACH with both of US Patent 6,045,038 (hereinafter SMITH), or of US Patent 6,182,823 (hereinafter RINDE), and arrive at the invention claimed. It will be noted here that neither one of AUERBACH, SMITH, AND RINDE disclose a paper dispenser as specifically pointed to in the claims. This appears to show that the interdependency between the claimed features of

- “paper dispensing”,
- “frustopyramidal shape”,
- “illustration or marking on the exterior face an interior wall”, and
- “opening to see therethrough the illustration or marking on the interior wall”.

was neglected by the office action.

Secondly, with respect to SMITH, Applicant's understanding of the rationale provided in the Office Action is that such a person would have been motivated by the desire to make the AUERBACH box more aesthetically pleasing and/or to advertise the contents by incorporating. As detailed above, an assumption is made here that converting the AUERBACH container to a paper dispenser would have been obvious, with which applicant disagrees. However, even assuming that AUERBACH's device could be adapted for paper dispensing as suggested in the Office Action, applicant must disagree with the suggested rationale for a person skilled in the art of paper dispensing for combining the frusto-conical shape of the AUERBACH container to the opening taught by SMITH. In fact, the frusto-conical shape in AUERBACH is used to “make it possible for an observer to read the legends from a position above the containers” (lines 63 to 66). One skilled in the art of paper dispensing seeing a flat exposing container for candy such as taught by AUERBACH, would simply not have been led to referring to the SMITH box which discloses double walls in a parallel fashion. There simply would have been nothing to expose between the short inclined AUERBACH wall and the inner wall. In this respect, reference to the SMITH box would have appeared senseless to such a person.

It is noted here that even assuming that both 1) AUERBACH could be adapted for paper dispensing as suggested in the Office Action and 2) it could then be combined with the teachings of SMITH using the rationale suggested in the Office Action, combining the AUERBACH container with the SMITH double-walled box would not have led to the claimed invention, because SMITH, col. 19, line 58 and following, teaches activating an origami decoration such as a dinosaur mouth by unfolding of the box configuration, in a manner that the dinosaur mouth be visible through the window. There is simply no disclosure of an illustration or marking in SMITH to cure the deficiencies of AUERBACH.

Applicant disagrees with the rationale suggested in the Office Action for combining RINDE for reasons similar to those stated above, especially given the fact that RINDE discloses a CD packaging. Furthermore, the illustration disclosed by RINDE does not cure the deficiencies of AUERBACH. It appears to applicant that the Office Action neglects the interdependency between the claimed elements of providing the opening in an outer wall which is *inclined* relative to the inner wall bearing the illustration or marking. This is a consequence of the relation between the frustopyramidal shape of the four exterior walls and the rectangular-prism shape of the four interior walls and results in a very appealing visual appearance. Neither RINDE nor SMITH disclose an opening in an inclined wall to see an illustration or marking on a straight wall behind it, let alone the other claimed features including the fact of applying this principle to a paper dispenser. Henceforth, the resulting visual appearance resulting from the inclination of the outer wall is simply not a clearly predictable result from the teaching of RINDE.

Henceforth, at least for these reasons, the invention as claimed in claim 1 appears patentable over the art of record. All the other claims are either dependent from claim 1 or are also patentable for similar reasons. Reconsideration and withdrawal of all outstanding rejections to the claims under 35 USC 103 is thus respectfully solicited.

Notwithstanding the above, and to further advance prosecution of this application, applicant

wishes to take advantage of this communication to the Office to comment on some of the other points which are raised with respect to some of the claims.

In re Claim 2, ignoring the above and even assuming that AUERBACH's device could be adapted for paper dispensing as suggested in the Office Action, in applicant's view, the rationale referred to in the Office Action which would have prompted a person skilled in the art of paper dispensing for turning to WYNNE for obtaining a "slot extending downwardly from the top of both one of the exterior walls and a corresponding one of the interior walls to provide digital access to paper in the paper-receiving compartment", does not stand. The Office Action appears to neglect the interdependency of the paper dispensing function with the slot when referring to WYNNE which is adapted for "packaging, shipping and display of merchandises including candy, chewing gum, and so forth" (col. 1, lines 4 to 6). Dispensing articles such as candy, chewing gum, and so forth is simply not related to allowing digital access to dispense paper. Candy, chewing gum, and the like are grabbed by the entire hand, or picked, rather than being slid and pulled delicately as paper with the fingers. In applicant's view, given the above, there would have been no rationale to turn to WYNNE to cure the deficiencies of AUERBACH. Further, even assuming that the references could be combined as suggested in the Office Action, such combination still does not teach the claimed invention. WYNNE simply does not disclose a slot to provide digital access to paper in the paper receiving compartment. In this response, to make this discrepancy even clearer, claim 2 has been amended to specify that the slot is elongated, and extends downwardly along its length.

In re Claim 6, applicant disagrees with the exposed rationale : "to serve as a means of tying the side walls to the exterior and interior walls". This is not the function served by the flaps of the paper dispenser. The pairs of flaps are "folded inwardly to form a corresponding edge between two adjacent exterior walls". As visible when contemplating the exhibit which was provided to the Office in a previous communication, the material, once folded, can have a

tendency to return partially toward its original unfolded state. In the case of the flaps, this causes the flaps to be biased against one another inside the edge, and can thus contribute to define a neat edge which is free of unsightly gaps, which would be especially unattractive in the case of a paper dispenser which has a relatively important height and therefore a relatively important length along which such gaps are formed. Given the fact that the rationale is incorrect, the rejection cannot stand.

In re Claim 13, the Office Action appears to neglect the interdependency between the frusto-pyramidal outer walls, the rectangular prism shaped paper receiving compartment delimited by the inner walls, and the flaps which precisely fit between the four inner walls when folded against the bottom of the box. In applicant's view, it would not have been plain and unambiguous that the flaps taught by Hillmann could be used in a frusto-pyramidal paper dispenser as claimed.

In re new Claims 17 and 18, as noted above, due to its adaptation to its intended use, the AUERBACH container is wide and relatively flat, allowing wide and separated exposure of the articles. A paper dispenser is logically relatively taller, in order to allow housing and dispensing of a reasonable amount of paper. Furthermore, the angle of inclination of the outer walls is quite different, to maintain its practicality in its use environment - typically a desk. New claims 17 and 18 clearly point to this discrepancy with AUERBACH by clearly spelling out that the paper-receiving compartment of the paper dispenser is cubical. This feature was plain and unambiguously shown in the original figures and therefore does not constitute introduction of new matter.

Conclusion

The application is thus believed in condition for immediate allowance, and an early notice to that effect is earnestly solicited. In the event that there remain any questions concerning this response or the application in general, the Examiner is invited to communicate with the

undersigned so that prosecution of this application may be expedited.

Respectfully submitted,

By: 

Date

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